

REMARKS

In the Office Action, the Examiner rejected claims 1-25. No claims have been added, amended, or canceled by this paper. In view of the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Rejections under 35 U.S.C. § 112

In the previous Office Action, the Examiner rejected claims 2, 3, and 10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner asserted that “ICE and ITP are more like protocols [than interfaces].” Office Action Mailed July 13, 2004, page 4, line 5. Even though Applicants believe that it was proper to characterize ITP and ICE as interface types, Applicants previously amended claims 2, 3, and 10 in the interest of clarification.

In the latest Office Action, the Examiner withdrew the Section 112 rejections against claims 2, 3, and 10 but stated that “the examiner does not agree with the applicant in that the amendments ‘do not alter the scope of the claims.’” Page 2, lines 22-23. Applicants thank the Examiner for removing the rejections under Section 112, but respectfully decline to agree with the Examiner’s characterization of the previous claim amendments. In particular, Applicants submit that the amendments at issue merely clarified features *already present* in the claims 2, 3, and 10. As such, Applicants assert that, at the very least, the previous amendments did not narrow the scope of claims 2, 3, and 10.

Rejections under 35 U.S.C. § 103

In the Official Action, the Examiner rejected claims 1-25 under 35 U.S.C. § 103(a) as being unpatentable by Li et al. (U.S. Patent No. 6, 598, 193, hereafter referred to as Li) in view of Falik et al. (U.S. Patent No. 6,606,078 hereafter referred to as Falik). Applicants respectfully traverse the Examiner's rejections.

The Examiner's Surprise Use of Official Notice is Improper

In the most recent Final Office Action, the Examiner took Official Notice *for the first time* in rejecting claims 16-20. As such, Applicants seasonably traverse this action by the Examiner and assert that it is improper for the Examiner to inform Applicants that the Examiner is taking Official Notice for the first time in a Final Office Action.

Independent claim 16 recites, in part, a "method of communicating with an integrated circuit in a managed server, the managed server having a remote server management controller[,]...the remote server management controller having an IOP and a JTAG master disposed thereon for operative communication with each other." In the Office Action mailed July 13, 2004, the Examiner conceded that the Li reference "fails to specifically cite an IOP (IO Processor) operatively connected to the management controller, and a JTAG master interface," but asserted that "*one with ordinary skill in the art would know* that the management controller of Li et al. would contain these two features, because the invention *would not operate without them.*" Office Action Mailed July 13, 2005, page 7, lines 12-16 (emphasis added). Applicants interpreted this passage as a claim of inherency by the Examiner. See M.P.E.P 2112. Applicants, believing that these claim features are not inherent

in the Li reference, traversed the Examiner's rejection in the previous Response to Office Action mailed October 13, 2004. In that Response, Applicants noted that the Examiner bears the evidentiary burden to provide a basis in fact to support a claim of inherency. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990); M.P.E.P. 2112; Response to Office Action mailed October 13, 2004, pages 18, 19, and 26. Accordingly, Applicants traversed the Examiner's rejection, because the Examiner provided no basis in fact, as outlined in M.P.E.P. 2112. *See id.*

In the most recent Office Action, rather than provide a basis in fact for the Examiner's apparent previous claim of inherency, the Examiner stated that "the wording in the examiner's rejection (i.e., 'one with ordinary skill in the art would know that [the device] would contain these two features...') is a *statement of official notice* by the examiner." Page 3, lines 19-21 (emphasis added). Applicants respectfully challenge and traverse both this assertion and the Examiner's surprise use of Official Notice in a Final Office Action.

Applicants respectfully remind the Examiner that Section 2144.03 of the M.P.E.P. clearly sets forth the language that an Examiner should use in taking Official Notice. In particular this Section explains that "[i]n limited circumstances, it is appropriate for an examiner to take *official notice* of facts not in the record or to rely on '*common knowledge*' in making a rejection, however such rejections should be judiciously applied." (Emphasis added). Because the Examiner did not use the terms "Official Notice" or "common knowledge" or any of the other terminology normally associated with the use of Official

Notice in M.P.E.P. 2144.03, Applicants submit that the *Examiner did not clearly indicate* the Examiner's reliance on Official Notice in the previous Office Action.

Accordingly, Applicants assert that the finality of the latest Office Action is improper, because the Examiner's surprise use of Official Notice is tantamount to a entering new rejections against claims 16-20. Because this "new" rejection was not necessitated by a change in scope of independent claim 16, this action is clearly improper. *See* M.P.E.P. 706.07(a). As such, Applicants respectfully request that the Examiner remove the finality of the most recent Office Action and consider the arguments set forth below.

The Examiner's Unclear Legal Assertions Prejudice Applicants' Rights

Applicants also assert that the Examiner's use of Official Notice for the first time in a situation that was *not* necessitated by Applicants' actions is unfair, because it substantially prejudices Applicants' right to respond. Specifically, Applicants assert that the Examiner's statements place Applicants at a substantial disadvantage, because the Examiner's previous rejections were unclear at best. As such, Applicants did not have proper or fair opportunity to respond to the first Office Action. Accordingly, Applicants respectfully request that the Examiner remove the finality of the most recent Office Action and consider the arguments set forth below.

Moreover, the Examiner's statements in the present Final Office Action also call into question the Examiner's current rejections of independent claims 1, 9, 21, and 24. For example, in the Examiner's rejection of claims 1 and 9, the Examiner stated that "one with

ordinary skill in the art would know that the management controller of Li et al. would contain a processor” Office Action, Page 5, lines 18-21. This choice of language by the Examiner is substantially similar to the language that the Examiner equated with Official Notice in the previous response. As such, based on the Examiner’s recent statements, it is impossible for Applicants to determine whether the Examiner is taking Official Notice, suggesting that claims features are inherent, or suggesting that claim features are common knowledge (*see* M.P.E.P. 2144.03). In light of this ambiguity, Applicants are clearly prejudiced in their ability to respond. Accordingly, Applicants request that the Examiner clearly state in a future non-final Office Action **whether the Examiner is taking Official Notice, asserting inherency, or suggesting that claims features are common knowledge for each of the rejected claims**. Because the Examiner has yet to clearly set forth rejections for the present claims, only a future **non-final** Office Action will provide Applicants with a fair opportunity to respond to the Examiner’s rejections.

Request Evidence to Support Official Notice

Applicants respectfully remind the Examiner that it is **not appropriate** for “the examiner take official notice of facts without citing a prior art reference...[unless the facts asserted to be well known are] capable of *instant and unquestionable* demonstration as being well-known.” M.P.E.P. 2144.03 (emphasis added). Because the Examiner’s assertions that the Management Controller of the Li reference would contain an IOP and a JTAG master interface is clearly not capable of “instant and unquestionable demonstration,” Applicants respectfully request that the Examiner *produce evidence* in the form of a reference to support of the Examiner’s position in accordance with M.P.E.P. 2144.03. Indeed, to the extent that

the Examiner has relied upon Official Notice as to other claimed elements, Applicants respectfully request the production of evidence in the form of a reference for these other elements as well. Applicants also remind the Examiner that it is the Examiner's burden to provide a reference to support the rejection. Without such a reference, the Examiner's rejections based on Official Notice cannot stand and should be withdrawn. If the Examiner is able to find such a reference and applies it in combination with the presently cited references, Applicants further request that the Examiner specifically identify the portion of the newly cited reference that discloses the allegedly "well known" elements of the present claims along with a suggestion to combine the new reference with references already cited.

Request for Basis in Fact to Support Determination of Inherency

To the extent that the Examiner appears to still be relying on inherency to disclose features of independent claims 1, 9, 21, and 24, Applicants again remind the Examiner that when the Examiner relies on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (emphasis added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner *must provide a basis in fact and/or technical reasoning* to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990). The Examiner, in presenting the inherency argument, bears the

evidentiary burden and **must adequately satisfy this burden or withdraw the rejection.**

See id.

As the Examiner has still not provided a basis in fact or technical reasoning to reasonably support the Examiner's potentially (see discussion above) inherency-based rejections of claims 1-15 and 21-25, Applicants traverse the Examiner's rejections and request that the Examiner either provide a basis in fact in a future Office Action or withdraw the pending rejections against claims 1-15 and 21-25.

Several Claim Features are not Disclosed by the cited References

As stated in the last Response, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Turning now to the claims, Applicants respectfully assert that several features of independent claims 1, 9, 16, 21, and 24 are not disclosed by the cited references. For example, independent claims 1 and 9 recite a JTAG master that is “configured to be accessed remotely through the remote server management controller to provide *communication* between a remote computer and the at least one integrated circuit *via the JTAG interface*.” (Emphasis added). Independent claim 16 recites a method of communicating with an integrated circuit in a managed server comprising “receiving *data at the IOP* of the remote server management controller; transmitting *the data* from the IOP to the JTAG master; and transmitting *the data* from the JTAG master to the integrated circuit via the JTAG interface.” (Emphasis added). Independent claim 21 recites “connecting a computer to a remote server management controller” and “communicating with an integrated circuit...via a JTAG interface.” Lastly, independent claim 24 recites a JTAG master “configured to be accessed remotely through the remote server management controller to provide *communication between a client computer and the integrated circuit via the JTAG interface*.” (Emphasis added).

The Examiner’s rejection of independent claims 1, 9, 16, 21, and 24 is insufficient, because the cited references do not teach or suggest, alone or together, the claim features recited above. As explained on pages 23, 27, and 28 of the last Response, the Li reference merely discloses a one-way, conventional file transfer between the management controller 102 and the remote systems 126 *via bus 118 and Ethernet controller 122*. See col. 4, lines 56-65; Fig. 4. Contrary to the Examiner’s assertions, the mere fact that the transferred file

happens to include JTAG-based test results does not make the file transfer either communication or communicating “via the JTAG interface,” as recited in claims 1, 9, 21, and 24. In other words, transferring a file *created by and stored on* the management controller 102 via Ethernet simply *does not equate* to the claim features recited above. Moreover, the one-way file transfer of the Li reference does not equate to the features recited in claim 16, because the test results disclosed in the Li reference are being transferred in a different direction than “the data” recited in claim 16. *See id.* The Falik reference cannot cure the above-described deficiencies in the Li reference, because, as described in detail in the previous response, the Falik reference does not disclose a remote computer, much less the above-recited claim features.

In addition, as explained on at least pages 20-22, 26, and 28 of the previous Response, neither of the cited references discloses an “IOP,” as recited in claims 1, 9, and 16 or “an embedded JTAG master that is *controllable by the IOP*,” as recited in claims 1 and 9. (Emphasis added). Applicants respectfully remind the Examiner that the Examiner has still not provided any evidence that either the Li reference or the Falik reference discloses an “IOP” or “an embedded JTAG master that is controllable by the IOP,” as recited in the above-referenced claims. In fact, the Examiner has expressly conceded that the Li reference does not disclose an IOP. *See* Office Action mailed July 13, 2004, page 5, lines 15-16. As stated in the previous response, the Examiner reliance on the Falik reference to cure this admitted deficiency is misplaced because the Falik reference only discloses a single figure containing a box labeled “I/O” in representation of an I/O device. As such, Applicants respectfully submit

that a single box labeled “I/O” is simply is not sufficient to disclose either an “IOP” or “an embedded JTAG master that is controllable by the IOP.”


For at least the reasons set forth above, it is clear that the Li reference and the Falik reference, taken alone or in combination, fail to teach or suggest the above-recited features of independent claims 1, 9, 16, 21, and 24. As such, Applicants assert that independent claims 1, 9, 16, 21, and 24 and the claims that depend thereon are patentable over the Li reference in light of the Falik reference.

Conclusion

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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